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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/925,826 | 08/09/2001 | Yuri Kazakevich | 00167-428001 | 4667 |

7590 06/19/2003

FRANK R. OCCHIUTI
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804

EXAMINER

MULCAHY, JOHN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3739 | /0 |

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

| | | |
|------------------------------|-----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/925,826 | KAZAKEVICH, YURI |
| | Examiner John M. Mulcahy | Art Unit 3739 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11, 13, 14 and 16-26 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 10, 11 and 13-26 is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6 and 9</u> | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2 and 6 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hoeg et al. (6,371,909). See Fig. 15 and its description.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (6,371,909) in view of the Examiner's official notice.

Hoeg et al. fails to show a chain and sprocket. However, the Examiner takes official notice that it was notoriously old and well known to use a chain and sprocket for analogous purpose. Inasmuch as Hoeg et al. specifies a mechanical linkage (col. 10, lines 29-36), it would have been obvious to the artisan to modify Hoeg et al. by using a

chain and sprocket in place of the mechanical linkages disclosed since the artisan would expect such to work equally as well.

b. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (6,371,909) in view of Klieman et al. (5,827,323).

Hoeg et al. fails to show a push rod and rack and pinion. However, Klieman et al. shows an analogous endoscope utilizing such an arrangement (see Figs. 2, 10 and 11). Inasmuch as Hoeg et al. specifies a mechanical linkage (col. 10, lines 29-36), it would have been obvious to the artisan to modify Hoeg et al. by using a push rod and rack and pinion as taught by Klieman et al. in place of the mechanical linkages disclosed since the artisan would expect such to work equally as well.

c. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (6,371,909) in view of the Examiner's official notice.

Hoeg et al. fails to show fluid or air ports. However, the Examiner takes official notice that it was notoriously old and well known to provide such fluid and air ports on analogous endoscopes. It would have been obvious to the artisan to modify Hoeg et al. by adding such ports since such would allow the objective lens to be cleaned *in situ*.

d. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (6,371,909) as applied to claim 1 above, further in view of Wilk et al. (WO 93/15648).

Hoeg et al. fails to show a transmitter. However, Wilk et al. teach an analogous endoscope having a transmitter 156 and power source 158. It would have been

obvious to the artisan to modify Hoeg et al. by adding such a transmitter, etc., since Wilk et al. teach such to be advantageous.

Allowable Subject Matter

3. Claims 10, 11, 13, 14 and 16-26 are allowed.

Final Rejection

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Mulcahy whose telephone number is (703) 308-3134. The examiner can normally be reached on M-F, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.



John Mulcahy
June 13, 2003

John M. Mulcahy
Primary Examiner
Art Unit 3739